

to the statement made at page 2 of the office action where the examiner writes:

the affidavits placed of record to establish patentability have no probative value since they fail to overcome the teachings of the secondary reference.

If, by that statement, the examiner means that the comparison should be between applicant's claimed compound and the closest prior art compound, as modified by the teachings of the secondary reference, then the examiner is, in effect, asking applicants to compare their claim compound with itself. Such a requirement is obviously improper. In a paper entitled "The Use of Affidavits and Declarations During Ex parte Prosecution" presented by Saul I. Serota, Examiner in Chief, USPTO, Mr. Serota states "the closest prior art compound should be compared with the claimed compound. It is unnecessary for the applicant to compare the claimed compound with the closest compound of one reference as proposed to be modified by the examiner in light of the other references, since to do so would be to compare the claimed compound with itself." Citing In re Tiffin, 170 USPQ 88(CCPA 1971) and other cases.

The real issue of record, at least in the view of the undersigned, is as stated in the opening remarks above, i.e. whether or not the ten-fold superiority of applicant's compound as compared to the closest prior art would have been expected from a reading of the prior art references. In this regard, the examiner writes:

it appears to the examiner that the advantage relied upon for patentability by applicants would be inherently present in the reference since Example 29 shows the same diester combination. It would be interesting to find out what observations could be made when comparing the biological properties of betamethasone-17-valerate-21-acetate against the compound in Example 29. In all probability the therapeutic effectiveness of the di-acylate in Example 29